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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,913	05/21/2002	Jose Castillo Deniega	IFLOW.063NP	2831

20995 7590 07/16/2008
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EXAMINER

MACNEILL, ELIZABETH

ART UNIT	PAPER NUMBER
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3767

NOTIFICATION DATE	DELIVERY MODE
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07/16/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary	Application No. 10/031,913	Applicant(s) DENIEGA ET AL.	
	Examiner ELIZABETH R. MACNEILL	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-28, 73, 74 and 76-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-28, 73, 74 and 76-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 18-28, 73, 74 and 76-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ekholmer (US 4,717,379).

Ekholmer teaches a catheter comprising an elongated support (5) constructed from a first material; and a porous membrane (distal portion of the catheter, see that pores 4 do not appear at the proximal end of the catheter in Fig 1 and Fig 4) constructed from a second material that is wrapped around an entire circumference of the support (Fig 2), said support having a lumen between the porous membrane and the support (3), where fluid enters the proximal end of the lumen and exits through the pores (4, Fig 1). The catheter further includes a tubular, non-porous membrane (proximal end of 1, which does not have pores 4, Fig 1 and Fig 4) which is wrapped around the support.

Ekholmer does not expressly disclose (1) that the first and second membranes are made of a different material or (2) that the porous and non-porous sections of catheter 1 are "separate."

(1) The cross-hatchings in the figures indicate that they are different materials, as well as the description (Col 2 lines 20-40) of making the catheter. Additionally, a porous membrane is generally flexible and may be difficult to position in the body without extra support, so it would be beneficial to provide a more rigid support. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use two different materials for the support and porous membrane as this is suggested by the drawings and description and would provide the additional benefit of having a more rigid inner catheter.

(2) Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made make the porous and non-porous section separate since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. An added benefit of making the porous and nonporous membranes separate would be that the medical personnel could customize the length of each piece (and therefore the infusion area) based on the patient's anatomy and desired treatment. For example, a small child might need to shorter catheter and a shorter infusion section than a full grown man. Without separate sections, the physician would only be able to shorten the overall length of the catheter, not both the infusion section and overall length. See MPEP 2144.04 (V) (C), "*In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "**if it were considered**

desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, **it would be obvious to make the cap removable** for that purpose."). Emphasis added.

As to claim 20, 21, 27, 73, 80, 82, 83 see "Of course it would be possible to instead provide the inner tube 3 with longitudinal partitions 7 on the outside, at which the outer tube 6 can be plane" and Fig 2, which shows ribs (7) that porous membrane (1) is wrapped around. See also Fig 3 for "dome-shaped end portion."

As to claim 22, 75, 85, 86 see Fig 4, non-porous membrane (8).

As to claim 23, 24, 76, 77 see Fig 2 and paragraph spanning Col 1-2, which suggests all the passages are separate.

As to claim 25, 78, 84 the device must be somewhat flexible in order to be guided into the body for a long insertion time and without irritation (Summary of the Invention)

As to claim 26, 79 guidewire lumen (2)

As to claim 28, 81 Ekholmer does not disclose the dimension of the pores. Instead, they are described as "very small capillary holes." It would have been obvious to one of ordinary skill in the art at the time the invention was made to use pores of less than .023 microns since it has been held that selecting an optimum dimension involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

2. Applicant's arguments with respect to claims 18-28 and 73-86 have been considered but are not persuasive. Applicant provides three arguments against the

rejection. Applicant first argues that the distal portion of the catheter is not porous. Porous is defined by Cambridge as "something that has many small holes, so liquid or air can pass through." Elkomer clearly meets this definition. Applicant next argues that it would not be obvious to make the porous and non-porous sections separate. Applicant cites the MPEP at 2144.04 (V) (B) which discusses whether or not it is obvious to make things integral. The more relevant section, (C), discusses making something integral into separate pieces. As discussed above, if the examiner provides a reason for making the two pieces separate than it would be obvious to do so. See examiner's reasoning as to the adjustability of the infusion section. Lastly the applicant argues that the dome shaped end portion is not integral with the tubular support. See Fig 3 which shows the tubular support has a slanted edge and consider that the porous membrane is secured to the support. Two things may be integral (attached) and separate (distinct, individual). For example, your fingers and thumb are integral (connected to your hand) but they are also separate (distinct from one another).

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH R. MACNEILL whose telephone number is (571)272-9970. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth R MacNeill/
Examiner, Art Unit 3767
/Kevin C. Sirmons/
Supervisory Patent Examiner, Art Unit 3767

Application/Control Number:
10/031,913
Art Unit: 3767

Page 7